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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)  
1322/62

"Express Mail" mailing number: EV944037366US

Date of Deposit May 11, 2007

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Shaylor D. Anderson

Application Number  
09/721,287

Filed  
November 22, 2000

First Named Inventor  
Peter J. Marsico

Art Unit  
3628

Examiner  
Borissov, Igor N.

Applicant requests review of the rejection of the claims in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

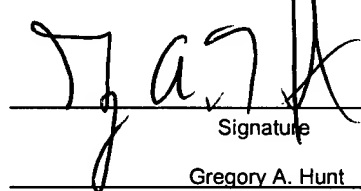
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☒ attorney or agent of record.  
Registration number 41,085

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. \_\_\_\_\_

  
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Signature  
Gregory A. Hunt  
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Typed or printed name

919-493-8000  
\_\_\_\_\_  
Telephone number

May 11, 2007  
\_\_\_\_\_  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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PATENT

Stacy D. Anderson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Marsico et al.

Group Art Unit: 3628

**Serial No.: 09/721,287**

Examiner: Borissov, Igor N.

Filed: November 22, 2000

Docket No.: 1322/62

Confirmation No.: 2195

For: METHODS AND SYSTEMS FOR AUTOMATICALLY REGISTERING COMPLAINTS  
AGAINST CALLING PARTIES

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APPLICANTS' STATEMENT IN SUPPORT OF THE  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1, 4, 6, 7, 14, 20, 23, 24, 26, 27, 29-33, 37, 39, 42 and 44 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,449,474 to Mukherjee et al. (hereinafter, "Mukherjee").

Claim 3 is rejected under 35 U.S.C § 103(a) as unpatentable over Mukherjee in view of U.S. Patent No. 6,701,160 to Pinder et al.

Claims 5, 28, 34-36, 43 and 45 are rejected under 35 U.S.C § 103(a) as unpatentable over Mukherjee in view of U.S. Patent No. 5,644,629 to Chow.

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mukherjee in view of U.S. Patent No. 5,751,800 to Ardon.

Claims 19 and 25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mukherjee in view of U.S. Patent 6, 668,175 to Almgren et al.

Due to the 5-page limit for this statement, the remarks below address the rejections of the independent claims only. The rejections of the dependent claims should be reversed for the same reasons stated herein with regard to the corresponding independent claims. In addition, the rejections of the dependent claims should be reversed based on Applicants' arguments regarding the dependent claims presented in the amendment under 37 C.F.R. §1.116 filed concurrently herewith, which are hereby incorporated herein by reference in their entirety.

Independent Claims 1, 26, and 50

Independent claims 1, 26, and 50 recite methods and a system for automatically registering complaints against communication initiators when the communication is from a party with whom the intended recipient does not desire to communicate. Each of claims 1, 26, and 50 recite identifying, from a signaling message, whether a communication, such as a call, is from a communications initiator with whom an intended recipient does not desire to communicate and automatically generating and sending a complaint registration message over a data network.

The Office Action fails to set forth a prima facie case as to how any portion of Mukherjee discloses or renders obvious a method or a system where it is determined whether a communication is from a communication initiator with whom an intended recipient does not desire to communicate. Mukherjee is directed to a call intercept system for law enforcement purposes when a subscriber uses multiple numbers.<sup>1</sup> Mukherjee indicates that the invention described therein is directed to intercepting calls for law enforcement. Calls are monitored if they are of interest to law enforcement. There is no description of any analysis of a call to determine whether the call is unwanted from the perspective of the communication recipient. Presumably, calls being monitored by law enforcement are wanted from the perspective of the "malicious subscriber" or "suspect" who is described as the monitoring target in Mukherjee.

On page 10, in the Response to Arguments section of the Office Action, the Examiner indicates as follows:

In response to applicant's argument that Mukherlee [sic] fails to teach or suggest hardware for determining whether a communication is from a communication initiator with whom the intended recipient does not desire to communicate, it is noted that Mukherlee specifically teaches dealing with malicious callers, resulting in a connection made to a law enforcing agency. Under the "broadest reasonable interpretation" the examiner considers such calls made by said malicious callers as "unwanted" calls.

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<sup>1</sup> For example, Mukherjee states: As a result, tracking the subscriber becomes impossible. For originating calls using this service, a caller dials any number. If the mobile station is only identified by its LNP number, then tracking or call interceptive calls or the originator becomes difficult. As a result, a malicious mobile subscriber may elude monitoring agencies. Given this situation, a subscriber has the capability to remain anonymous to a law enforcement agency if all that is known to the law agency is the LNP or some private number of the subscriber. Thus, it would be advantageous to have an improved method and apparatus for providing call interception for calls involving IN services. (Emphasis added.) (See column 1, line 62 through column 2, line 6 of Mukherjee.)

This reasoning is flawed because it fails to consider 1) the stated purpose of Mukherjee of call interception for law enforcement purposes or 2) Applicants' claim language which indicates that the determination made by the presently claimed invention is whether the communication is "from a communications initiator with whom the intended communication recipient does not desire to communicate." In other words, the determination recited in claims 1, 26, and 50 is whether the communication is unwanted from the perspective of the intended recipient. According to the passage from columns 1 and 2 of Mukherjee cited by the Examiner, a "malicious mobile subscriber" may have "the capability to remain anonymous to a law enforcement agency". In this passage, it is implied that the "malicious mobile subscriber" is someone who is of interest to a law enforcement agency, rather than someone who is making a call that is unwanted from the perspective of the communication recipient. In other locations, Mukherjee describes the target of the call intercept as "a suspect". (See column 5, line 61 of Mukherjee.) The term "suspect" implies a suspect in a criminal investigation, rather than someone whose call is unwanted from the perspective of a communication recipient. In other locations, Mukherjee describes the target of the call intercept as "the recipient of the call." (See column 6, line 35 of Mukherjee.) The recipient of the call cannot possibly be someone with whom an intended recipient does not desire to communicate because it would require that the recipient make a determination as to whether the call is from himself.

Accordingly, it is respectfully submitted that because Mukherjee is directed to intercepting calls for law enforcement purposes, Mukherjee cannot possibly render obvious the step of determining whether a communication is from a communication initiator with whom the intended recipient does not desire to communicate, as recited in independent claims 1, 26, and 50. Thus, for this reason alone, the rejection of claims 1, 26, and 50 and their dependent claims should be reversed.

Moreover, each of these claims recite automatically generating a complaint registration message and transmitting the complaint registration over a data network. On page 10, the Office Action indicates that column 6, lines 14-26<sup>2</sup> of Mukherjee disclose this

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<sup>2</sup> Col 6. lines 14-20 of Mukherjee state as follows: Upon receipt of this number MSC 404 searches call intercept table 406 to identify the corresponding entry for the returned number to retrieve other call interception related information. Then the call may be monitored. In this example, the call intercept information also may include an identification of the law enforcement agency or agencies to receive call intercept information, a number for connecting to the law enforcement agency, and the type of data to be sent to the law enforcement agency. In this example, the call intercept includes sending data to law enforcement agency 410. Communication with law enforcement agency 410 is achieved by establishing a communications link using a TCP/IP protocol.

feature. The Office Action misinterprets this passage from Mukherjee. The cited passage from Mukherjee indicates that when a call is monitored, call interception information is sent from MSC 404 to law enforcement agency 410. The call interception information is described in this passage as information identifying the law enforcement agency, a number for connecting to the law enforcement agency, and the type of data to be sent to the law enforcement agency. None of these types of data has anything to do with unwanted call complaint registration. Accordingly, it is respectfully submitted that for this additional reason, the rejection of claims 1, 26, and 50 and their dependent claims as unpatentable over Mukherjee should be reversed.

#### Independent Claim 20

Independent claim 20 recites a method where a user communications terminal determines, from a signaling message, whether a communication is from a communications initiator who has been previously notified not to communicate with the intended recipient, and, in response, automatically generating and sending a complaint registration message over a data network.

As stated above with regard to independent claims 1, 26, and 50 Mukherjee is directed to intercepting calls for law enforcement purposes. There is absolutely no description anywhere in Mukherjee of identifying callers who have been notified not to initiate communications with a particular recipient. Thus, for this reason alone, the rejection of claim 20 and its dependent claims as unpatentable over Mukherjee should be withdrawn.

Moreover, independent claim 20 recites that the determination as to whether a call has been previously notified not to initiate communications with a communications recipient is performed at a user communications terminal. Even assuming for the sake of argument that Mukherjee discloses the step of determining whether a communication is from a communication initiator who has been notified not to initiate communication with a communication recipient, the call intercept intelligence in Mukherjee resides at MSC 404 and SCP 402, neither of which is a user communication terminal. MSC 404 is a mobile switching center, which is a switch for a mobile telecommunications network. Similarly, SCP 402 is a network database. There is no reasonable interpretation of Mukherjee where the intelligence for performing call monitoring could reside at the user communication terminal because the user communication terminal is under the control of the "malicious mobile subscriber" or "suspect". There is no description in Mukherjee of how a user device

that is the control of such a person would be modified for call interception purposes. Accordingly, because Mukherjee fails to disclose any intelligence for identifying repeat unwanted callers that resides at the user communication terminal, for this additional reason, the rejection of claim 20 and its dependent claims as unpatentable over Mukherjee should be reversed.

Independent Claim 45

Independent claim 45 recites a computer program product comprising computer executable instructions embodied in a computer readable where, once a communication is allowed to be completed, a manual trigger from the recipient identifies the communication as unwanted, and a complaint registration message is automatically generated.

Mukherjee and Chow fail to disclose or render obvious identifying a communication as unwanted from the perspective of a communication recipient or generating a complaint registration message. For the reasons set forth above, Mukherjee is directed to call interception for law enforcement purposes and has nothing to do with identifying a communication as unwanted from the recipient's perspective. Chow is directed to routing calls to voice mail. Accordingly, it is respectfully submitted that the rejection of independent claim 45 as unpatentable over Mukherjee in view of Chow should be withdrawn.

CONCLUSION

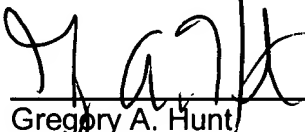
For the reasons set forth above, the rejection of the claims should be reversed.

Respectfully submitted,

JENKINS, WILSON, TAYLOR & HUNT, P.A.

Date: May 11, 2007

By:



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